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D E C I S I O N
of 19 October 1994

Case Number: T 0930/92 - 3.4.1

Application Number: 82109014.9

Publication Number: 0075949

IPC: H01J 37/30

Language of the proceedings: EN

Title of invention:
Ion beam processing apparatus and method of correcting mask defects

Patentee:
Hitachi, Ltd.

Opponent:
ICT Integrated Circuit Testing Gesellschaft für Halbleiterprüftechnik mbH

Headword:
Ion beam processing/HITACHI LTD.

Relevant legal provisions:
EPC Art. 56, 104, 133
EPC R. 63, 71

Keyword:
"Inventive step (yes)"
"Oral proceedings appointed following auxiliary requests by both parties"
"No communication under Article 11(2) RPBA"
"Appellant failed to appear at oral proceedings as summoned"
"Apportionment of costs in favour of Respondent"
"Fixed amount ordered"
"'Reasonable' level of costs"

Decisions cited:
T 0003/90

Headnote:
I. There is an equitable obligation upon every party who is summoned to oral proceedings to inform the EPO as soon as it knows that it will not attend as summoned. This is the case whether or not that party has itself requested oral proceedings, and whether or not a communication has accompanied the summons to oral proceedings.

II. If a party who has been summoned to oral proceedings fails to attend as summoned without notifying the EPO in advance that it will not attend, an apportionment of costs in favour of another party who has attended as summoned may be justified for reasons of equity in accordance with Article 104(1) EPC.

III. When fixing the amount of costs to be paid to a party, in addition to the remuneration of the professional representative of that party, the expenses incurred by an employee of that party in order to instruct the professional representative before and during oral proceedings may be taken into consideration under Rule 63(1) EPC, if such instruction was "necessary to assure proper protection of the rights involved."

Case Number: T 0930/92 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 3.4.1
of 19 October 1994

Appellant: (Opponent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office dated 3 August 1992 rejecting the opposition filed against European patent No. 0 075 949 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairman: G. D. Paterson
Members: Y. J. F. van Henden
R. K. Shukla

Summary of Facts and Submissions

I. European patent No. 0 075 949 comprising eleven claims was granted to the Respondent.

Claim 1 of this patent reads:

"An ion-beam processing apparatus for correcting a defect consisting of the unwanted presence of material in a fine circuit pattern drawn on a surface of a specimen, said apparatus being provided within a vacuum container (39) including a specimen chamber (40) with a table (55) for mounting said specimen (90) therein, and comprising:

an ion source (65) facing said specimen chamber (40),

an extraction electrode (67) for extracting an ion beam (68) from said ion source (65),

a first aperture (69) for controlling the spot diameter and spot current of said ion beam (68) when focused to a spot on said specimen (90),

at least one set of electrostatic lenses (70, 71, 72) for focusing said ion beam (68) outputted through said first aperture (69) to form a spot (68) on the surface of said specimen (90),

X-axis and Y-axis deflection electrodes (75, 76) for scanning said ion beam spot (68') over said specimen (90) in two mutually orthogonal directions,

a secondary charged particles detector (86) for detecting the intensity of secondary charged particles emitted from said specimen (90) when subjected to the ion beam and for transducing said intensity into an electrical signal and

display means (87) receiving said signal from said detector (86) and X- and Y-deflection signals applied to said deflection electrodes (75, 76) for scanning a spot having an intensity proportional to said signal from said detector (86) in synchronism with said ion beam spot (68') scanning over said specimen (90) so as to allow observation of the surface of said specimen (90), wherein

said ion source (65) is of the liquid metal type or of the ultra-low temperature electric field ionisation type generating a high intensity ion beam (68) to form a spot (68') of less than or equal to 0.5 µm diameter on said surface of said specimen (90) through said first aperture (69) and said set of electrostatic lenses (70, 71, 72),

said apparatus further comprises setting means (696) for setting a range of co-ordinates (X_1-X_2, Y_1-Y_2) relative to said X- and Y-axes, said range defining a region of the surface of said specimen (90) to be processed and said range also being displayed on said display means (87),

a second aperture (74) is provided between at least a portion of said set of electrostatic lenses (70, 71, 72) and said deflection electrodes (75, 76) for interrupting the projection of said ion beam (68) onto said specimen (90),

a beam-blanking electrode (73) is disposed upstream said second aperture (74),

a power controller (85) is provided to supply a blanking signal, in dependence on said setting means (696) and said X- and Y-direction signals, so as to operate on the beam-blanking electrode (73) to deflect the ion beam out of said second aperture (74) except

when the beam spot (68') lies within the said region to be processed and

switching means (112) are provided for switching power supplies (78, 79, 80,81) and said power controller (85) supplying said ion source, electrodes and lenses so as to selectively provide a low-power ion beam suitable for scanning the surface of said specimen (90) without damaging said pattern, so that said defect may be observed on said display means (87), and a high-power ion beam suitable for scanning the said region to be processed, which region may include said defect, and for sputtering the material constituting said defect so that said defect may be removed",

three minor spelling mistakes having been corrected in the claim.

Claims 2 to 10 are dependent upon Claim 1. Independent Claim 11 is a method claim which reads as follows:

"A method for correcting a defect consisting of the unwanted presence of material in a fine circuit pattern on a mask, said method comprising the steps of:

extracting an ion beam (68) out of a high intensity ion source (65) by means of an extraction electrode (67),

focusing said ion beam (68) into a fine spot (68') having a spot diameter of less than or equal to 0.5 µm by means of an electro-optical system (70, 71, 72) and a first aperture (69),

deflecting said ion beam (68) by means of X-axis and Y-axis deflection electrodes (75, 76) along two mutually orthogonal directions for scanning said spot (68') over said mask (90) along said directions,

detecting the intensity of secondary charged particles emitted from said mask (90) when exposed to a low-power ion beam by means of a secondary charged particles detector (86) transducing said intensity into an electric signal,

displaying said intensity on a display means (87) through a spot having an intensity proportional to the output of said secondary charged particles detector (68) and being scanned over said display means (87) in synchronism with said ion beam (68) scanning an area of the surface of said mask (90) in accordance with deflection signals applied to said deflection electrodes (75, 76) so as to enable the observation of said surface area of said mask (90),

setting a defect portion to be corrected on said mask (90) by means of setting means (696) acting on said display means (87),

switching the power of said ion beam (68) irradiated onto said surface of said mask (90) between a low-power value for detecting a surface area to be corrected on said mask (90) by means of said secondary charged particles detector (86) and a high-power value for correcting a defect portion (92) indicated by said setting means (696) through said ion beam (68),

blanking said ion beam (68) by deflecting it out of a second aperture (74) by means of a beam blanking electrode (73) and deflecting said ion beam (68) be means of said deflection electrodes (75, 76) in accordance with a signal produced by said setting means (696) and

removing said defect portion (92) of said mask (90) by sputtering",

a minor spelling mistake having been corrected in the claim.

II. The Appellant filed an opposition against the above European patent, citing the documents

D1: "Scanning microbeam using a liquid metal ion source", T. Ishitani et al., J. Vac. Sci. Technol., 20(1), Jan. 1982, American Vacuum Society, pages 80-83,

D2: US-A-3 517 191,

D3: "Small area depth profiling with the ion microprode", T. A. Whatley et al., Surface Analysis Techniques for Metallurgical Applications, ASTM STP 596, American Society for Testing and Materials, 1976, pages 114-125, and

D4: "Microprobe for the ion bombard mass analyzer", H. Tamura et al., in "Recent Developments in Mass Spectroscopy: Proc. Int. Conf. on Mass Spectroscopy, Kyoto", ed. K. Ogata, publ. Baltimore, Univ. Park Press, 1970,

and requesting that said patent be revoked on each of the grounds mentioned in Article 100 EPC.

In the course of the proceedings before the Opposition Division, the Appellant additionally cited

D5: "The very bright field ionization and field evaporation ion sources. Some uses. A beam formation and scanning system", H. Heil et al., Proc. Symp. on Ion Sources and Formation of Ion Beams, Oct. 19-21, 1971, Brookhaven National Laboratory, Upton, NY, USA, pp. 183-189,

D6: "High-resolution, ion-beam processes for microstructure fabrication", R. L. Seliger et al., J. Vac. Sci. Technol. **16**(6), Nov./Dec. 1979, pp. 1610-1612, and

D7: "In-depth analysis in selected area with ion microprobe analyser", H. Tamura et al., Proc. 6th Internl. Vacuum congr. 1974, Japan. J. Appl. Pys. Suppl. 2, Pt. 1, 1974, pp. 379-382,

whereas the Opposition Division drew attention to the following documents which had been cited in the European Search Report:

DD: Patents Abstracts of Japan, Vol. 5, No. 86 (E-60)[758], 5th June 1981; & JP-A-56-33829, and

DE: Patents Abstracts of Japan, Vol. 5, No. 186 (E84)[858], 25th November 1981; & JP-A-56-111227.

During oral proceedings held on 24 June 1992 before the Opposition Division, the Appellant withdrew its objections under Article 100(b) and (c) EPC.

III. The Opposition Division rejected the opposition, grounding its decision in substance as follows:

The patent in suit validly claims the priority of a patent application filed in Japan before document (D1) was published. The latter, therefore, may not be taken into consideration. In pursuance of Article 114(2) EPC, this also applies to the late filed document (D7) which admittedly teaches that an etching rate can be adjusted by varying the intensity of an ion beam. This is not the same as using a low-power beam which does not damage the surface for observing a workpiece. Moreover,

(D7) teaches to position the analysing beam at the preselected point, rather than scanning it over a region where it is desired to carry out an analysis.

The invention belongs to the technical field of pattern defect correction by micromachining. None of the documents cited by the Opponent (Appellant) and published before the priority date of the European patent belongs to this field: (D2), (D3) and (D4) relate to scanning ion microscopy; (D5) mentions micromachining as a possible application of ion beams, while (D6) describes micromachining of a gold layer on silicon. Furthermore, (D5) and (D6) are rather academic papers. Only document (DE) relates to pattern defect removal, and actually by means of a laser beam. Document (DE) also discloses setting means comprising an image control part (10) and two pairs of electronic cursors (13), which are positioned so as to bracket the defect (7).

The subject-matter of Claim 1 differs from the prior art known from (DE) in that defect detection and correction are carried out by a scanned ion beam produced from an ion source of the liquid metal or ultra-low temperature field emission type. Document (D5) would not have incited a skilled person to use such a source for it states that, "in order to work on such a new application ..., it is necessary ... to show its usefulness or relevance". Document (D6) is more relevant, since it discloses ion beam micromachining to produce features of such small width as 38 nm using a liquid gallium source. Nevertheless, there is a distinction between using an ion beam to draw a pattern and using an ion beam to correct pattern defects, which

requires greater control of beam power and direction. A skilled person knowing that, in direct analogy to the teachings of (DE), a shaped ion beam could be used, would not be incited to adopt the ion beam scanning system of (D6), and no blanking electrode would be needed. Likewise, neither would the need for an ion beam scanning system in conjunction with a detector of secondary charged particles and synchronised display means be felt, since the device of (DE) provides a video image of the specimen surface. There would also be no need to switch between high and low power beams. As in (DE), cursors would locate the defect on the video screen, the specimen support table would be moved so as to centre the defect with respect to the ion beam, the latter would be appropriately shaped and the high-power beam would be switched on to sputter off the defect. Therefore, Claim 1 involves an inventive step and, for the same reasons, so does Claim 11.

IV. The Opponent lodged an appeal against the decision of the Opposition Division, requesting that said decision be set aside, that the European patent be revoked and, subsidiarily, that oral proceedings be scheduled if the Board intended to uphold the impugned decision.

In support of these requests, the Appellant argued in substance as follows:

The effect to be achieved by the invention, namely removing unwanted matter from a fine circuit pattern, does not involve a limitation of the claimed protection. For this reason, the patent in suit must be classified in the broader field of ion beam techniques for producing circuits. This field includes devices for

making circuits as well as devices for correcting defects and, usually, the same apparatus carries out both tasks.

Document (D5) discloses an ion beam processing apparatus using a liquid metal ion source by means of which the beam diameter can be made as small as 1 nm. From Figure 1a and the related part of the description, the following features of the apparatus claimed in the European patent are known: extraction electrode, limiting aperture, electrostatic lens and electric deflection system. When envisaging to machine a workpiece in a selected region, however, it is of obvious necessity to provide setting means. Likewise, in order that material be removed only from the selected region, it is necessary to provide a second aperture (74) between at least a portion of the electrostatic lenses and the deflection electrodes, a beam blanking electrode and a power controller operating the latter except when the beam spot lies within the selected region to be processed. Finally, document (D5) also suggests the possibility of using a signal derived from the emission of secondary charged particles. This would incite the skilled person to provide a detector of such particles and a display device, whereby the necessity of switching between a low power and a high power of the ion beam would be obvious.

Therefore, the teachings of (D5) and the common general knowledge of the skilled person are already enough to arrive, without having to display inventive talent, at the subject-matter claimed in the European patent.

Document (D6) too relates to an ion beam processing apparatus of the kind referred to a Claim 1. The spot of the beam extracted from the liquid metal source mentioned there has a diameter in the range of 0.1 to 0.5 µm. In Figure 1, the following features of the claimed apparatus are represented: extraction electrode, aperture, lens and deflection. To the skilled person, providing the remaining features of said claimed apparatus is a mere question of routine.

The skilled person would also consider the teachings of (D7), since it discloses the removal of unwanted matter from a selected region by scanning an ion beam. Figure 2 shows a deflector, a collector of secondary charged particles and a cathode ray tube displaying an image of the workpiece's surface. Besides, the features necessary to produce the ion beam are implicitly disclosed and, here again, providing the remaining features of Claim 1 is a question of routine. Furthermore, varying the beam energy in accordance with the desired etching speed is also known from (D7). If only a display of the surface to be locally processed is wished, it is consequently obvious that the beam intensity must then be set at a low value.

V. The Respondent (Proprietor of the patent) requested that the appeal be dismissed, that the patent in suit be maintained as granted and, subsidiarily, that oral proceedings be held.

The Respondent's arguments, insofar as they do not repeat those of the Opposition Division, may be summarised as follows:

Micromachining to remove unwanted material in the mask pattern of integrated circuits requires apparatus different from those used for fabricating or analysing microstructured circuitry. This observation is actually the more relevant as the Appellant admitted that a plurality of features characterising the present invention are not found in the references cited.

Document (D5) just teaches that material can be sputtered off when a high brightness beam is used. Document (D5) thus discloses only one use of the ion beam and even leads away from using an ion beam both for detection and correction. Document (D6) teaches that resolution is improved if ion beams are patterned to small dimensions before they strike the surface to be machined. Finally, document (D7) only discloses a scan-stop method for performing in-depth analysis by means of a mass spectrometer. The primary ion beam is positioned at a selected point and the mass spectrometer is set at a pre-selected value of mass to determine the quantity of ions of the corresponding species. The difficulties found in the prior art and mentioned in the patent cannot be overcome by a combination of these teachings. It is by providing an apparatus using the same ion beam for detecting a defect and subsequently removing it, whereby only an increase of the beam power is needed, that the invention achieves this result.

VI. The Board summoned the parties to oral proceedings to be held on 19 October 1994, without issuing a communication pursuant to Article 11(2) RPBA.

VII. The Respondent's representative appeared at the date and time fixed for the oral proceedings, accompanied by two employees of the Respondent company, one being an inventor, and the other being a member of the Respondent's Patent Department.

The Appellant's representative did not appear and, in a phone call made by the Registrar of the Board before the proceedings began, he stated that he would not attend the proceedings.

The Chairman opened the oral proceedings, and stated that the Board intended to dismiss the appeal and to maintain the patent as granted, and that no further submissions from either party concerning the substantive issue of patentability would be admissible.

The Respondent's representative stated that a request for apportionment of costs would be filed in writing.

The Chairman stated that the appeal proceedings would be continued in writing with respect to the apportionment of costs, and closed the oral proceedings.

VIII. The Respondent's written request for apportionment of costs was filed on 21 November 1994, and contains a request that the following costs which were incurred by the Respondent should be awarded against the Appellant:

Flight tickets for the two employees of the Respondent company, Tokyo - Munich - Tokyo, (copies were enclosed):	DM 20,927,20
Hotel expenses for the above two employees (a copy of the bill was enclosed)	DM 2,812,20
Travel expenses for the above two employees Yokohama-Tokyo-Yokohama (estimated)	DM 300,--
Extra expenses for the above two employees for food during their stay (estimated)	DM 1,400,--
Public transport for the above two employees within Munich and to and from the airport (estimated)	DM 50,--
Renting a video equipment	DM 57,50
Renumeration of the professional representative (1 attorney, 3 1/2 days)	DM 8,750,--
Total:	DM 34,296,90

In support of the above request, the Respondent submitted essentially as follows:

Since the Board came to a preliminary opinion on the written submissions that the appeal should be dismissed, no oral proceedings were necessary from the Respondent's side. It is the duty of a party to inform the other party and the Board if he does not intend to

appear as summoned, in order to avoid unnecessary costs being incurred.

The Appellant was informed by letter dated 29 July 1994 which was written in connection with fixing the date for oral proceedings that representatives of the patent Proprietor's company would attend the oral proceedings, and he indicated in reply to the Respondent (but not to the Board) that the Appellant might not attend the oral proceedings. However, such an indication was clearly too uncertain for the Respondent to cease preparation for the oral proceedings.

The Appellant therefore knew that the Respondent's preparations for the oral proceedings in October 1995 would incur high costs, and had plenty of time to make up his mind whether or not to attend such proceedings, and if not, to inform the Respondent and the Board in good time in advance of 19 October 1995.

IX. The Board invited the Appellant to respond to this request for costs within two months. The Appellant's reply was filed on 26 January 1995.

(1) The Appellant submitted that the Respondent's request for an award of costs should be rejected, essentially for the following reasons:

(a) According to Article 104(1) EPC, each party to opposition proceedings should bear its own costs, unless a different apportionment is ordered for reasons of equity. There are no reasons of equity in the present case to justify a different apportionment of costs.

In principle a party to opposition proceedings is free to choose whether or not to attend oral proceedings which have been arranged by an Opposition Division or a Board of Appeal, subject to the following exceptions:

(1) The first exception is when the parties can see that the oral proceedings have been arranged as a consequence of an auxiliary request of only one party. In such a case the party at whose request the oral proceedings have been arranged is obliged either to attend the oral proceedings or to notify the EPO in advance that it will not attend.

The present case is not such a case, because both parties had made an auxiliary request for oral proceedings so the oral proceedings had not been arranged specifically for either one of them. From the Appellant's point of view the oral proceedings had not been arranged specifically following its auxiliary request.

(2) A second exception is when the Opposition Division or Board of Appeal has issued a communication accompanying the invitation to oral proceedings, which indicated a preliminary view against a particular party. In such a case that party is also obliged to notify its intention not to

attend the oral proceedings in good time in advance of the appointed day.

In the present case no such communication was issued by the Board of Appeal.

Furthermore:

(3) Since about July 1993 invitations to oral proceedings from the EPO have been accompanied by a form entitled "Important information concerning oral proceedings" (Form 2043.2.07.93) which states inter alia that a party who does not wish to attend oral proceedings on the date appointed is requested to notify the EPO immediately, and in urgent cases to notify other parties as well. This form also states that costs incurred by other parties may be charged to a party who either fails to notify such parties of his non-attendance, or does not notify them in good time.

In the present case no such form was sent with the invitation to oral proceedings.

(b) The Appellant also contested the extent of the costs claimed by the Respondent, as not being justified in equity, for the following reasons:

(1) The Japan-based Respondent is represented by a patent attorney based in Munich, who appeared alone at the oral proceedings

before the Opposition Division. The patent Proprietor had no proper reason to send its employees to the oral proceedings before the Board of Appeal in addition to the patent attorney, and it would be unfair to award costs in respect of the attendance of the two employees from Japan.

(2) Furthermore the costs of two employees travelling from Japan goes beyond the scale envisaged under Article 104 EPC.

(3) The length of the two employees stay in Munich was also excessive for the preparation for oral proceedings.

(4) The preparations during three and a half days by the patent attorney were also excessively long.

X. The Respondent replied to these contentions in a letter filed on 21 February 1995.

Reasons for the Decision

1. *Inventive step*

1.2 Drawing attention to page 188 of document (D5), second paragraph of the right-hand column, the Appellant submitted that the teachings given there would incite a person skilled in the art of ion beam micromachining to provide, in an apparatus for correcting defects in fine

circuit patterns, a detector of secondary charged particles and a display device receiving the signal outputted by said detector as well as X- and Y-deflection signals for scanning, in synchronism with the deflection of the ion beam, a spot having an intensity propositional to said signal from the detector of secondary charged particles so as to allow observation of a selected region of a circuit pattern.

The Board nonetheless observes that the cited passage of (D5) refers to a measure of current intensity in a spot and teaches that, for this purpose, determining the removal rate of a target's material is preferred to the use of, inter alia, a secondary ion or electron signal. Furthermore, the use of a signal desired from the secondary emission of charged particles is clearly excluded from the considerations of (D5). It is indeed stated there that a quite unconventional detection system was used because of an impossibility of using secondary charged particles for signal generation - see page 184, second paragraph of the left hand column. Besides, the mention of a component of a device in relation with a particular use thereof does not provide an incentive to review all possible uses of this component, especially if such uses require the provision of further components.

In the Board's judgment, therefore, document (D5) does not incite the skilled person to provide the means recited in Claim 1 of the European patent for displaying an image of a selected area to be machined. The same conclusion also applies to document (D7) which discloses the use of a detector of secondary charged

particles for the sole purpose of performing an analysis by means of a mass spectrometer.

1.3 In relation to a plurality of features mentioned in Claim 1 of the patent in suit, in particular the provision of a second aperture (74) for beam forming, that of a beam blanking electrode and that of a power controller for operating the latter, the Appellant submitted that such features are part of the skilled person's common general knowledge.

According to the jurisprudence which has been developed by the Boards of Appeal of the EPO, however, the common general knowledge of the particular art in which a person is skilled is in most cases constituted by the contents of handbooks and textbooks - see for instance the decision T 206/83 (OJ EPO, May 1985), point 5 of the reasons. Nevertheless, though its attention had already been drawn to this point by the Opposition Division, the Appellants never submitted evidence that the features referred to here would form part of the skilled person's common general knowledge.

In the Board's judgment, therefore, it is not established that a skilled person starting from the teachings of (D5) and relying on his common general knowledge would arrive in an obvious manner at the invention defined by the independent Claims 1 and 11 of the patent in suit. This conclusion remains valid when starting from the teachings of (D7), where collection of secondary charged particles serves the purpose of analysing by means of a mass spectrometer, and also when starting from the teachings of (D6) for they do not extend beyond those of (D5).

1.4 The Appellant's submissions thus do not invalidate the conclusions of the Opposition Division, which are adopted by the Board.

2. The grounds mentioned in Article 100(a) EPC consequently do not prejudice the maintenance of the patent in suit as granted to the Respondent. The appeal is therefore dismissed.

3. *Apportionment of costs: principles*

3.1 Article 104(1) EPC provides that an Opposition Division or a Board of Appeal may order an apportionment of costs incurred in oral proceedings, in accordance with the Implementing Regulations, and "**for reasons of equity**".

3.2 Article 116(1) EPC states that "Oral proceedings shall take place ... at the request of any party to the proceedings ...", and Rule 71(1) EPC states that "The parties shall be summoned to oral proceedings provided for in Article 116 EPC". A summons is an authoritative call to attend at a specified time and place for a specific purpose, namely for holding the oral proceedings. By issuing such a summons, a Board of Appeal commits itself to holding oral proceedings at the specified time and place, as part of the related appeal proceedings. As a party to the appeal proceedings, a party who receives such a summons (whether or not it has requested oral proceedings pursuant to Article 116 EPC) has an equitable obligation either to appear at the oral proceedings at the specified time and place, or to notify the Board as soon as it knows that it is not going to appear at such

oral proceedings. This is the case whether or not that party has itself requested oral proceedings, and whether or not a communication has accompanied the summons to oral proceedings.

If a party only knows shortly before the specified time for the oral proceedings that it is not going to attend, such equitable obligation extends also to informing any other parties to the appeal proceedings of such non-attendance. Even then, a party who only decides at such a late stage not to attend oral proceedings runs the risk of an apportionment of costs to compensate for the unnecessary incurring of costs by other parties.

Thus as a matter of legal principle, the Board does not accept the submissions of the Appellant set out in paragraph IX above, to the effect that a party is in general free to choose whether or not to attend oral proceedings to which he has been summoned, without giving notice to the Board and other parties if he chooses not to attend, subject only to the particular exceptions which are there set out. On the contrary, as explained above, there is a general equitable obligation upon every party who is summoned to oral proceedings to inform at least the Board as soon as it knows that it will not attend as summoned, in order that the Board can then decide the proper future procedural course of the proceedings.

Furthermore, the Board does not accept the Appellant's contentions to the effect that a party is only obliged to notify the Board of his non-appearance at oral proceedings if it can see from the course of the

proceedings that such oral proceedings have been arranged as a result of its request for such proceedings. The control of the appeal procedure lies with the Board of Appeal, not with the parties to the proceedings. Consequently, the Board of Appeal should always be informed if a party does not intend to appear at oral proceedings.

3.3 If a party duly notifies the Board that it will not attend oral proceedings in accordance with a summons, the procedural consequences will vary, depending in particular upon which parties to the appeal proceedings have requested oral proceedings under Article 116, and also depending upon the particular circumstances of the case.

In a case such as the present, namely opposition appeal proceedings involving two parties, the patent Proprietor (Respondent) and the Opponent (Appellant), in which both parties have requested oral proceedings on an auxiliary basis, clearly the Board cannot decide the case in favour of either party without first appointing oral proceedings. When issuing the summons to oral proceedings in such a case in accordance with Article 11(2) of the Rules of Procedure of the Boards of Appeal (OJ EPO 1983, 7) the Board may (or may not) send a communication accompanying the summons, and it may or may not, in accordance with Article 12 RPBA, include in such a communication a possible appreciation of substantive or legal matters which arise in the case.

Whether or not a communication under Article 11(2) RPBA has been issued, if one of the parties subsequently

(but in advance of the day appointed for the oral proceedings) withdraws his request for oral proceedings (or states that he will not attend the oral proceedings, which is normally considered as equivalent to a withdrawal of the request for oral proceedings, see Decision T 3/90, OJ EPO 1992, 737), from the point of view of the Board of Appeal it then becomes procedurally appropriate to review the procedural situation and to decide whether or not the oral proceedings should still take place. If, at that stage in the procedure and at that point in time, having regard to the written submissions of both parties on file, the Board intends to decide the case in favour of the party who has withdrawn its request for oral proceedings, it is then still necessary to hold the oral proceedings having regard to the outstanding auxiliary request of the other party. On the other hand, if at that point in time, the Board intends to decide the case in favour of the party whose auxiliary request for oral proceedings is still outstanding, the proper procedural course would then be for the Board to issue a decision in favour of that party without holding any oral proceedings.

3.4 In the circumstances of the present case, in which the Appellant failed to notify the Board in advance of the time appointed for oral proceedings that it would not attend such proceedings, the Board was unable to carry out such a review of the procedural situation. If the Appellant had notified the Board in good time before the day appointed for the oral proceedings that it would not attend such oral proceedings, the Board would have been able to review the case having regard to the changed procedural situation, and would then have

reached the conclusion that it in fact reached at the oral hearing, namely that it intended to decide the case in accordance with the Respondent's request to dismiss the appeal. Since the Respondent had requested oral proceedings only in case that a decision to dismiss the appeal could not be made having regard to the written submissions of the parties, the Board would then have been able to cancel the oral proceedings.

It follows that by failing to notify the Board in advance of the hearing that he would not attend the hearing, the Appellant was directly responsible for the unnecessary incurring of costs by the Respondent in preparing for and attending the oral hearing.

In the Board's judgment, therefore, for reasons of equity and in accordance with Article 104(1) EPC, in the circumstances of the present case an apportionment of costs in favour of the Respondent will be ordered.

3.5 Apart from the fact that the Appellant's failure to inform anybody of his intention not to appear at the oral proceedings caused unnecessary costs to be incurred by the Respondent, the Board would also draw attention to the inconvenience and waste of time caused to the Board. If a party who has been duly summoned to oral proceedings fails to appear as summoned, in the absence of any prior notification, before commencing oral proceedings at the appointed time, a Board will normally feel equitably and morally obliged to make enquiries by telephone to check whether the non-appearing party is known to be on his way and may have been delayed while travelling. Such enquiries were carried out in the present case.

3.6 In the Board's view, the sending or otherwise by the EPO of a form such as Form 2043.2.07.93 accompanying the summons to oral proceedings (see paragraph IX(a)(3) above) is irrelevant to the question whether an apportionment of costs should be ordered having regard to the relevant equitable principles as set out above. Such principles are applicable whether or not such a form is sent. The sending of such a form is a mere "courtesy service", not required by the EPC.

3.7 Although the legal principles discussed above have been considered in the context of appeal proceedings, it will be apparent that such principles are equally applicable **mutatis mutandis** in proceedings before the Opposition Divisions.

4. *Apportionment of costs: fixing the amount*

4.1 Although Article 104(2) EPC provides that "On request, the registry of the Opposition Division shall fix the amount of the costs to be paid ...", in the Board's view this procedural option is clearly inappropriate in a case such as the present.

Rule 63(1) EPC provides that an apportionment of costs "shall only take into consideration the expenses necessary to assure proper protection of the rights involved." Furthermore, the costs "shall include the remuneration of the representatives of the parties."

4.2 In paragraph 22 of a notice entitled "Opposition procedure in the EPO" (OJ EPO 1989, 417), which was issued by the EPO in connection with proceedings before the Opposition Divisions, it is stated that "If a party

fails to appear, without adequate excuse, at oral proceedings arranged at his request, he bears the full costs incurred by the other party, provided these are reasonable in the circumstances." The Board endorses this statement in the context of appeal proceedings, and considers that the principles underlying this statement are applicable in a case such as the present, where oral proceedings were arranged as a result of requests by both parties, but would not have been necessary if the party who in fact failed to appear had withdrawn his request for oral proceedings in good time before the day appointed for such proceedings.

4.3 The further question to be considered by the Board is thus whether the expenses which have been claimed by the Respondent were "necessary to assure proper protection of the rights involved", and were reasonable in the circumstances of the case. In support of this claim, the Respondent has explained why the subject-matter of the case is of considerable commercial importance to him. This is not contested by the Appellant, although he has submitted that the Respondent's claim is excessively high.

Having regard to Article 133(2) EPC, since the Respondent company does not have either its residence or its principal place of business within one of the contracting States, it is obliged to be represented in proceedings under the EPC by a professional representative.

In the Board's view, the costs of remuneration of the Respondent's professional representative in preparing for and attending the oral proceedings during three and

a half days were clearly necessary to assure proper protection of the rights involved, and are reasonable, having regard to the nature of the subject-matter of the case (i.e. DM 8 750).

Furthermore, during such preparation and attendance at the oral proceedings, in the Board's view it was also necessary to assure proper protection of the Respondent's rights for at least one member of the Respondent company to be present for the purpose of instructing the professional representative both before and during the oral proceedings. Accordingly, in the Board's view the claimed costs for one person travelling from Yokahama to Munich and back were also reasonable in the circumstances (i.e. DM 10 500). Similarly, the claimed costs of one person staying in a hotel in Munich (DM 1 400), and some minor incidental expenses are also reasonable (DM 100).

The Board does not consider that the other costs claimed were "necessary to assure proper protection of the rights involved."

4.4 According to Rule 63(2) EPC, final sentence, "Costs may be fixed once their credibility is established." The Board accepts the credibility of the costs claimed by the Respondent. The costs which have been claimed have been supported by appropriate evidence. The Respondent has confirmed that during the three and a half days which are the subject of the claim, this was the only case discussed with the representative.

In the Board's judgment, therefore, for reasons of equity the Appellant shall pay the Respondent by way of

apportionment of costs the sum of DM (8 750 + 10 500 + 1 400 + 100), i.e. DM 20 750.

Order

For these reasons it is decided that:

1. The appeal is dismissed.

2. The Appellant shall pay the Respondent the sum of DM 20 750, by way of apportionment of costs.

The Registrar: The Chairman:

M. Beer G. D. Paterson